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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,030	07/25/2001	Robert Alan Musson	971-129	7035

7590 12/10/2004

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EXAMINER

BACKER, FIRMIN

ART UNIT PAPER NUMBER

3621

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/915,030	Applicant(s) MUSSON, ROBERT ALAN	
	Examiner Firmin Backer	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

This is in response to a letter for patent filed on July 25<sup>th</sup>, 2001 in which claims 1-21 are presented for examination. Claims 1-21 are pending in the letter.

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 1 recites the limitation "the executable" in paragraph 1 line 1. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 101*

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

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- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” and therefore are found to be non-statutory subject matter. For a method claim to pass the muster, the recited method must somehow apply, involve, use, or advance the technological arts.

In the present case the inventive concept in claim 1 only recites an abstract idea. The recited do not apply, involve, use or advance the technological arts since all the steps can be performed in the mind of the user or by use of pencil and paper and no specific technology (e.g. computer, processor) is expressly recited in the body of the claims. *In re Toma (CCPA 197 USPQ 852 (1978))*.

Although the recited method produces a useful, concrete and tangible result, since the claimed invention, as a whole, it not within the technological arts as explained above, claim 1 deemed to be directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Beery (U.S. PG Pub No. 2001/0034846 A1).

8. As per claims 1, 4, 5, Berry teaches a method of ensuring proper licensing, comprising the executable instructions of receiving a data file (set or executable instruction, MP3 file) removing at least a portion of the data file thereby prevention a use associated with the data file wrapping a license authentication set of executable instructions around the data file executing the license authentication set of executable instructions to determine whether the data file is associated with a valid license; and restoring the removed portion of the data file if the valid license exists thereby making the data file available for use (*see paragraphs 0021, 00223, 0025, 0038, 0039, 0046*).

9. As per claim 2, 3, Berry teaches a method of preventing the data tile from use if the valid license is not authenticated and notifying an owner if the data file does not have the valid license (*see paragraphs 0021, 00223, 0025, 0038, 0039, 0046*).

10. As per claim 6, Berry teaches a method of customizing the license authentication set of executable instructions based on a user license(*see paragraphs 0021, 00223, 0025, 0038, 0039, 0046*).

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11. As per claim 7, Berry teaches a method for providing the license authentication set of executable instructions to one or more application service providers wherein the license authentication set of executable instructions is customized based on one or more levels of service of the application service providers (*see paragraphs 0021, 00223, 0025, 0038, 0039, 0046*).

12. As per claims 8, Berry teaches a method of authenticating a licensed set of executable instructions, comprising the executable instructions of receiving a license set of executable instructions while a computing device housing the license set of executable instructions is in communication with one or more licensing computing devices executing the license set of executable instructions to determine if the license set of executable instructions is associated with a valid license, permitting the license set of executable instructions to further execute on the computing device if the valid license exists', and preventing the license set of executable instructions from further executing on the computing device if the valid license does not exist (*see paragraphs 0021, 00223, 0025, 0038, 0039, 0046*).

13. As per claim 9, Berry teaches a method of executing the license set of executable instructions while the computing device is not in communication with one or more of the licensing computing devices (*see paragraphs 0021, 00223, 0025, 0038, 0039, 0046*).

14. As per claim 10, Berry teaches a method wherein the license set of executable instructions is associated with providing a least one of audio, image, and video data (*see paragraphs 0021, 00223, 0025, 0038, 0039, 0046*).

15. As per claim 11-15, Berry teaches a method of removing at least a portion of the license set of executable instructions prior to executing the license set of executable instructions and only when the valid license exists and is associated with a dynamic linked library necessary for execution of the license set of executable instructions and is encrypted using public-private key resides within the license set of executable instructions (*see paragraphs 0021, 00223, 0025, 0038, 0039, 0046*).

16. As per claim 16 and 17, Berry teaches a method of notifying electronically a licensor of the license set of executable instructions if a fail attempt to execute the license set of executable instructions occurs without the valid license and is made as soon as the computing device is capable of being in communication with the licensing computing devices (*see paragraphs 0021, 00223, 0025, 0038, 0039, 0046*).

17. As per claim 18 and 21, Berry teaches a system for validating data tiles comprising a wrapping set of executable instructions operable to be executed prior to using a data file on a computing device, and a validation set of executable instructions called by the wrapping set of executable instructions operable to permit the data file to be useable on the computing device if a valid license to use the data file exists on the computing device (*see paragraphs 0021, 00223, 0025, 0038, 0039, 0046*).

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18. As per claim 19, Berry teaches a system wherein the data file is an executable set of instructions (*see paragraphs 0021, 00223, 0025, 0038, 0039, 0046*).

19. As per claim 20, Berry teaches a system wherein the validation set of executable instructions operates while the computing device is not in communication with any external computing devices (*see paragraphs 0021, 00223, 0025, 0038, 0039, 0046*).

### *Conclusion*

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (*see form 892*).

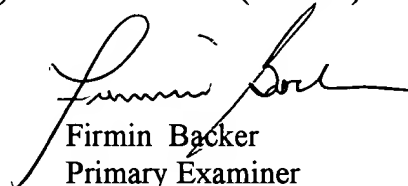
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Firmin Backer  
Primary Examiner  
Art Unit 3621

December 8, 2004